



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,467	03/28/2005	Per Moller	1175/74121	8292

7590 03/13/2006

Cooper & Dunham
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

LAVILLA, MICHAEL E

ART UNIT	PAPER NUMBER
----------	--------------

1775

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

Office Action Summary	Application No. 10/529,467	Applicant(s) MOLLER, PER	
	Examiner Michael La Villa	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20051013</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because of the following informalities: Regarding Claim 7, the copyright symbol should be replaced with the characters "(c)." Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
3. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Regarding Claim 1, it is unclear what is meant by the phrase "absorbing metal oxide." Does this phrase imply certain structural or compositional features, or does any metal oxide in any form meet this limitation? Is a metal surface that is subject to exposure to oxygen absorption encompassed by the claimed limitation? It is unclear whether the transition metal and catalytic metal are to be chosen such that the transition metal reduces the chosen catalytic metal or reduces any catalytic metal.
6. Regarding Claims 1, it is unclear how applicant's claim defines the catalytic metal ions since there is no subsequent step of catalysis. Therefore, it is unclear how one is to ascertain whether a deposited solution of so-called catalytic metal ions meets the claimed "catalytic" property.

7. Regarding Claim 6, it is unclear what is meant by the term “preferably.” Are only the specified ions what is being claimed? If not, it is unclear how the breadth of what is being claimed is affected by the term “preferably.”
8. Regarding Claim 10, it is unclear how the non-conducting material can both contain polymer as a main ingredient, as well as the materials of Claim 10.
9. Regarding Claim 12, it is unclear what is meant by choosing catalytic metal ions of platinum group ions, where the subsequent catalysis is not claimed.
10. Regarding Claims 13 and 14, it is unclear whether the claimed article is “obtained” by Claim 1 or merely “obtainable.” It is unclear whether this aspect of the claimed invention is a product-by-process limitation.
11. Regarding Claim 16, it is unclear whether this claim specifies the nature of the layers of Claim 15 or whether this claim specifies additional layers to be provided.
12. Regarding Claims 8, 10, and 11, it is unclear what is meant by the term “main.” Does this simply mean “important,” does it signify “at least 50 weight percent,” or does it have some other specific meaning?

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
14. A person shall be entitled to a patent unless –
15. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1775

16. Claims 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ejerer GB 1,401,600. Ejerer teaches a polymeric substrate that is coated with manganese dioxide, tin ions, palladium ions, and electroplated with a nickel layer. See Ejerer (page 1, lines 25-70; page 3, lines 35-100; page 4, lines 10-50).

17. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Cane USPN 5,648,125. Cane teaches depositing a manganese oxide layer on an epoxy/glass substrate, treating with a solution of tin, treating with a palladium solution, and forming an electroless nickel and electrolytic copper layers. See Cane (col. 28, line 40 through col. 29, line 41).

Conclusion


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1775

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael La Villa
6 March 2006



MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER